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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,772	11/28/2000	William F. Behm	SG-20554	6839

7590 11/03/2003
Michael B. McMurry
1210 Astor Street
Chicago, IL 60610

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,772

Applicant(s)

BEHM ET AL

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-302 is/are pending in the application.
- 4a) Of the above claim(s) 4-302 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Examiner acknowledges Applicant's response to the request to delete those portions of the specification that do not specifically pertain to the claimed invention. Applicant states that the changes would be *de minimis*. That being the case, no amendment to the specification or drawings is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 & 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Finocchio (US Patent Number 5,317,135).

Claim 1: Finocchio teaches a system for electronically validating a lottery ticket having player removable play spots covering play indicia. (Fig 3) Ticket data (verification code, validation code, etc.) are located on the lottery ticket. (Col 6, 56 – Col 7, 33) There is an electronic validation machine (Fig 1) including a detector (130-136) and a microprocessor (Col 4, 59-64) operatively connected to the detector. The microprocessor computes which of the game spots have been removed from the lottery ticket and the ticket redemption value from the play spots that have been removed and from the ticket data. (Col 6, 56 – Col 7, 33) Finocchio teaches that one of the play spots (302-306) contains the ticket verification code. (Col 7, 12-13) In order to determine if the ticket is a winner, the terminal scans the verification code. (Col 7, 13-18) Thus the

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microprocessor must determine which of the spots is removed because it must determine if the verification code is revealed.

Claim 2: Finocchio teaches displaying a message that tells the amount to be paid. (Col 7, 27-30) This is the redemption value.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finocchio as applied to claim 1 above.

Claim 3: Finocchio teaches the invention substantially as claimed. Finocchio teaches stigmatizing the lottery ticket by removing latex covering the verification code (308).

Finocchio teaches that this voids the card. (Fig 3A, Col 1, 40-49) This is done as part of the validation process (Col 7, 24-27), but is performed manually by the clerk. It has been held to be obvious to provide automatic means to replace manual activity. (*In re Vennel*, 120 USPQ 192.) It would have been obvious to one of ordinary skill in the art at the time of the invention to have had the electronic validation machine include means to stigmatize the lottery ticket in order to automate a manual process.

Response to Arguments

6. Applicant's arguments filed 21 August 2003 have been fully considered but they are not persuasive.

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7. Applicant argues that Finocchio fails to teach a device that can determine which spots have been removed from a lottery ticket and compute a ticket redemption value from the spots removed. Applicant points out that in certain cases, lottery cashiers must remove a latex area and enter a “verification code”. Applicant has made a completely understandable error.

8. Finocchio discloses two “verification codes”. The first “verification code” is concealed by the latex coatings overlying one of the areas (302-306). The player removes the latex coating from one of these spots, and the revealed number is scanned by the verification machine. (Col 7, 13-34) As suggested in the rejection, the validation machine must determine which of the spots is removed because it must determine if the verification code is revealed.

9. The second “verification code” is concealed under latex covering (308). This is the code that the lottery cashier manually enters into the terminal under certain circumstances. Finocchio clearly states that this is only done when the prize amount is larger than a certain value. (Col 7, 20-23)

10. Applicant argues that Finocchio fails to teach determining the value from the spots that have been removed. This is not the case. As Examiner interprets the reference, the player scratches off spot (302) to reveal a number. Then the player scratches off one or more of the spots (304-306) to attempt to match the number under (302). If the ticket is a winning ticket, one of the spots (304-306) will also cover a verification code. The validation machine must determine which spots (304-306) are uncovered and whether the verification code is revealed. The redemption value is determined using that data. (Col 6, 65 – Col 7, 34)

11. Furthermore, much of the prior art of record determines the redemption value of the lottery ticket by determining which spot is uncovered. See Sultan (US Patent Number

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6,273,817), Kamille (US Patent Number 5,996,997), Sanchez (US Patent Number 5,935,000) and Schroeder (US Patent Number 5,791,990). (Since Examiner cannot determine when the instant invention was disclosed in the string of Continuations-in-Part that make up the chain of priority in the instant case, Examiner assumes that the invention was disclosed in the latest filing. Thus these patents are presumed to be prior art. Applicant may rebut this presumption by pointing out the location in the previously filed applications that disclose the claimed invention.)

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


cbc


JESSICA HARRISON
PRIMARY EXAMINER